THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 26

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JOHN F. HARRIS

Appeal No. 96-4203
Application No. 08/409,550[1]

ON BRIEF

Before HAIRSTON, KRASS and DIXON, Administrative Patent Judges.

HAIRSTON, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 1 through 13. In an Amendment After Final (paper number 21), claims 11 and 13 were amended.

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[1] Application for patent filed March 24, 1995. According to the appellant, the application is a continuation of Application No. 08/133,685, filed October 7, 1993.

The disclosed invention relates to air-bearing surfaces on a slider.

Claim 1 is illustrative of the claimed invention, and it reads as follows:

1. A uniform fly height slider for reading and writing data on a planar rotating data storage medium, said slider comprising:

a generally rectangular body having a length identified by leading and trailing edges relative to rotation of the medium;

said body having an inner longitudinal edge traversing from said leading to trailing edges and located adjacent to a center of rotation of the medium;

said body having an outer longitudinal edge traversing from said leading to trailing edges and spaced from said inner longitudinal edge;

outer and inner air bearing surfaces extending parallel to each other and traversing from said leading to trailing edges;

said outer air bearing surface being spaced from said outer longitudinal edge of said body;

said inner air bearing surface being coincident with said inner longitudinal edge of said body to maximize the distance between said outer and inner air bearing surfaces;

an outer fly height control contour situated on an outer edge of said outer air bearing surface adjacent to said outer longitudinal edge of said body and traversing from said leading to trailing edge, said outer contour being recessed from said outer air bearing surface;

an inner fly height control contour situated on an inner edge of said outer air bearing surface and traversing from said leading to trailing edge, said inner contour being recessed from said outer air bearing surface; and

a shoulder situated between said outer contour and said outer longitudinal edge of said body and traversing from the leading edge to the trailing edge, said shoulder being recessed from said outer contour.

The references relied on by the examiner are:[2]

Matsuzaki et al. (Matsuzaki)	5,134,531	July 28, 1992
Okita et al. (Okita) (Japanese patent)	3-157861	July 5, 1991
Matsuzaki (Japanese patent)	3-132910	June 6, 1991

Claims 1 through 3 and 5 through 13 stand rejected under 35 U.S.C. § 103 as being unpatentable over Matsuzaki ‘910 in view of Okita.

Claim 4 stands rejected under 35 U.S.C. § 103 as being unpatentable over Matsuzaki ‘910 in view of Okita and Matsuzaki ‘531.

Reference is made to the brief and the answer for the respective positions of the appellant and the examiner.

OPINION

Matsuzaki ‘910 discloses a slider (Figures 1, 4 and 5) with air bearing members 11 and 12. The examiner acknowledges

[2] Copies of the translations for Okita and Matsuzaki are attached.

(Answer, page 3) that Matsuzaki '910 does not show an inner air bearing surface "coincident with the longitudinal edge of the slider."

Okita discloses a slider (Figures 1 through 8) in which both of the air bearing members are coincident with the longitudinal edge of the slider.

According to the examiner (Answer, page 4), "it would have been obvious to one of ordinary skill in the art at the time the invention was made to move the inner rail of Matsuzaki over in order to be coincident with the longitudinal edge . . . because doing this would help to stiffen the slider and increase the stability of the slider."

Appellant acknowledges (Brief, page 14) that it is known to locate "both air bearing rails coincident with a slider edge," but argues (Brief, pages 14 and 15) that impermissible hindsight would be needed on the part of the examiner to pick and choose from known features "in order to rebuild a prior device in the manner to provide for the first time an apparatus/method as claimed by appellant."

In the absence of a teaching or a suggestion in the applied references or a convincing line of reasoning by the

examiner for selecting only one of the air bearing members in Matsuzaki '910 to make coincident with the edge of the slider body when Okita clearly teaches to make both air bearing members coincident with the edge of the slider, we must agree with the appellant that the examiner has exercised impermissible hindsight in rejecting the claims on appeal. Thus, the 35 U.S.C. § 103 rejection of claims 1 through 3 and 5 through 13 is reversed because a prima facie case of obviousness can not be established based upon impermissible hindsight.

The 35 U.S.C. § 103 rejection of claim 4 is reversed because Matsuzaki '531 does not cure the noted shortcomings in the teachings of Matsuzaki '910 and Okita.

DECISION

The decision of the examiner rejecting claims 1 through 13 under 35 U.S.C. § 103 is reversed.

REVERSED

KENNETH W. HAIRSTON)
Administrative Patent Judge)
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	) BOARD OF PATENT
ERROL A. KRASS	) APPEALS
Administrative Patent Judge	) AND
	) INTERFERENCES
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JOSEPH L. DIXON	)
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